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09/927,914	08/10/2001	Timothy P. Tully	1314.2004-001	5180
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EXAMINER				
CHONG, YONG SOO				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

09/927,914

Applicant(s)

TULLY ET AL.

Examiner

YONG S. CHONG

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Yong S Chong/
Examiner, Art Unit 1617

Continuation of 11, does NOT place the application in condition for allowance because: Applicant argues that the Examiner misses the mark because the claimed invention is drawn to a method of increasing performance gain during treatment of a cognitive deficit. Applicant do not claim the phosphodiesterase inhibitor compounds themselves. Applicant also do not claim the general treatment of stroke patients via cognitive training. Christensen simply does not teach the treatment of a cognitive disorder by inhibiting phosphodiesterase 4 in order to enhance CREB pathway.

This is not persuasive because Christensen clearly discloses the claimed phosphodiesterase inhibitor while the Merck Manual discloses cognitive training, both references for the purpose of treating stroke victims. Applicant is reminded that a performance gain of a cognitive task in a stroke patient is an inherent property when the same compound is administered to the same patient at the same dose. Therefore, the "long lasting" and "enhancement of CREB pathway function" limitations are met because they are inherent properties. Moreover, the Examiner interprets performance gain of a cognitive task as covering a wide range of impairments, which include aphasia (language/speech disturbance) and apraxia (impaired ability to carry out motor activities), as disclosed in Applicant's own disclosure. Essentially, the scope of the instant claims covers administration of the phosphodiesterase inhibitors at any time to the patient. Therefore, Applicant's assertion that Christensen is simply teaching the administration of rolipram during the acute phase of the stroke to reduce TNF still meets the limitations of the instant claims as it relates to the Merck Manual reference.

Applicant also argues that an inherency argument is not appropriate in an obviousness rejection. It is submitted that Applicant's own disclosure cannot be an appropriate source of information. In short, the cited prior art references do not provide a teaching of a beneficial link between the inhibition of phosphodiesterases and cognitive training.

This is not persuasive because Applicant still does not understand that the inherency argument was not used to support the motivation in the obviousness rejection. Applicant's disclosure was merely used to show that the term "performance gain of a cognitive task" can be interpreted to cover a wide range of impairments, which overlap with the teachings of the prior art. Nonetheless, Applicant is invited to show factual data that performance gain would not result in the method taught by the cited prior art references.